



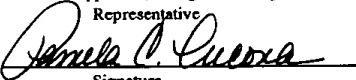
PATENT
KM39091-70

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Nacamulli et al.
Serial No. : 09/099,048
Reissue of : U.S. Patent No. 5,527,710
Filed : June 17, 1998
For : RATE MEASUREMENTS OF BIOMOLECULAR
REACTANTS USING ELECTROCHEMILUMINESCENCE
Group Art Unit : 1641
Examiner : NOT YET ASSIGNED

200 Park Avenue
New York, New York 10166

I hereby certify that his correspondence
is being deposited with the United States
Postal Service as first class mail in an
envelope addressed to:
Assistant Commissioner for Patents
Washington, D.C. 20231, on October 29, 1998

Pamela C. Ancona, Reg. No. 41,494
Name of Applicant, Assignee or Registered
Representative

Signature

October 29, 1998
Date of Signature

**PETITION TO SUSPEND THE RULES
UNDER 37 C.F.R. §1.183**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants hereby petition the Commissioner to suspend
the rules regarding the requirement for the signature of all
joint inventors on a Reissue Declaration and Power of Attorney.

11/04/1998 KHARLING 00000019 09099048

03 FC:122

130.00 OP

y438163.pcakm3909170

PATENT
KM39091-70

Enclosed herewith is a check in the amount of \$130.00 to cover the petition fee set forth in 37 C.F.R. § 1.17.

U.S. Application Serial No. 08/347,984 (the "'984 application"), now U.S. Patent No. 5,527,710, was filed on December 2, 1994, naming Laurette Nacamulli, Jonathan K. Leland, and Stephanie Hayes as inventors. At the time of filing, each of the inventors were employees of IGEN, Inc. and they assigned their rights to the '984 application to IGEN, Inc. Subsequently, Laurette Nacamulli left her position at IGEN, Inc. and she provided no forwarding address. Shortly thereafter, the '984 application issued as U.S. Patent No. 5,527,710 (on June 18, 1996).

After issuance, the patent was reviewed and it was determined that the issued claims did not provide protection for the entire scope of the invention. Specifically, the patent claimed less than the inventors had a right to claim, such that the patent failed to claim a method for determining the time course of a reaction and method for determining the concentration of a reactant.

Thus, the above-identified reissue application was filed on June 17, 1998 in order to broaden the scope of the claims in U.S. Patent No. 5,527,710. The reissue declaration was filed on June 17, 1998 and was signed by two of the three joint

inventors of the '984 application, i.e., Jonathan K. Leland and Stephanie Hayes.

On June 16, 1998, the undersigned attempted to contact Ms. Nacamulli to obtain her signature on the Reissue Declaration and Power of Attorney, using her last known address. A copy of that letter is enclosed as Exhibit A. When no response was received, a second letter was sent via registered mail on September 22, 1998 and a return receipt was requested. On September 24, 1998 the letter was returned to the undersigned, indicating on the envelope that the forwarding order expired, i.e. that Ms. Nacamulli no longer resided at that address and mail sent to that address was no longer being forwarded to her at her new address. Copies of the letter, return receipt, and envelope showing the return to sender stamp are enclosed as Exhibit B.

35 U.S.C. § 116 dictates how the remaining inventors may pursue an application despite their inability to find or reach a joint inventor after diligent effort. It states, in pertinent part:

If a joint inventor . . . cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the

Reissue Application of U.S. Patent No. 5,527,710
Serial No.: 09/099,048
Group Art Unit: 1641
Examiner: NOT YET ASSIGNED

PATENT
KM39091-70

application, subject to the same rights which the omitted inventor would have had if he had been joined.

By virtue of the undersigned's attempts to reach Ms. Nacamulli to obtain her signature on the Reissue Declaration and Power of Attorney, Applicants submit that a diligent effort has been made to contact Ms. Nacamulli.

Therefore, in view of the foregoing remarks and exhibits, it is respectfully submitted that Applicants have complied with 35 U.S.C. §§ 116 and 37 C.F.R. § 1.183. Therefore, Applicants request that the Commissioner suspend the rules in this instance and allow Applicants to pursue the above-identified reissue application without the signature of Ms. Nacamulli on the Reissue Declaration and Power of Attorney.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment resulting from this petition to Deposit Account No. 50-0297.

Respectfully submitted,

WHITMAN BREED ABBOTT & MORGAN, LLP
Attorneys for Applicants

By: 

Barry Evans

Reg. No. 22,802

John E. Boyd

Reg. No. 38,055

Pamela C. Ancona

Reg. No. 41,494

(212) 351-3000

WHITMAN BREED ABBOTT & MORGAN LLP

LONDON
TOKYO

200 PARK AVENUE
NEW YORK, N.Y. 10166

212-351-3000
TELECOPIER: 212-351-3131

TELEX: RCA 238436
WRITER'S DIRECT NUMBER

(212) 351-3033

GREENWICH
NEWARK
LOS ANGELES
PALM BEACH

June 16, 1998

CONFIDENTIAL

VIA FEDERAL EXPRESS

Ms. Laurette Nacamulli
5202 Crossfield Ct., #15
Rockville, Maryland 20852

Re: Reissue Application For
U.S. Patent No. 5,527,710 by Nacamulli et al.
Our Ref. No. KM39091-70

Dear Ms. Nacamulli:

We represent IGEN, Inc. regarding the above-identified matter. As you may know, a patent application, of which you were a named inventor, issued as U.S. Patent No. 5,527,710 on June 18, 1996. A copy of U.S. Patent No. 5,527,710 is attached.

After issuance, the patent was reviewed and it was determined that the issued claims did not provide protection for the entire scope of the invention. Thus, we have been instructed to file the above-identified application to reissue U.S. Patent 5,527,710.

As stated above, the patent claimed less than the inventors had a right to claim. Specifically, the patented claims are insufficient in that they fail to claim the method for

WHITMAN BREED ABBOTT & MORGAN LLP

Ms. Laurette Nacamulli

-2-

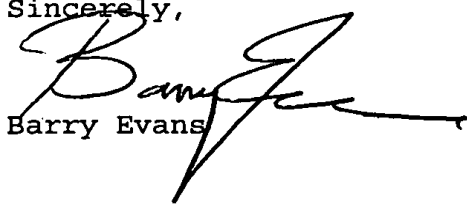
June 16, 1998

determining the time course of a reaction and method for determining concentration of a reactant set forth in the new proposed claims to be added in the reissue application (Attached). The new proposed claims do not recite steps (c) - (k) of patented claim 1 or limit the claims to a specific type of reaction.

Accordingly, we have enclosed an Inventor Declaration and Power of Attorney for your execution. The other named inventors, Jonathan K. Leland and Stephanie Hayes, will also execute copies of the Declaration. Please review the Declaration and enclosed documents and forward an executed Declaration to us at your earliest opportunity. We have enclosed a self-addressed envelope for your convenience.

If you have any questions or comments, please do not hesitate to contact us.

Sincerely,


Barry Evans

BE:JEB:kw
Enclosure

WHITMAN BREED ABBOTT & MORGAN LLP

LONDON
TOKYO

200 PARK AVENUE
NEW YORK, N.Y. 10166
212-351-3000
TELECOPIER: 212-351-3131
TELEX: RCA 238436
WRITER'S DIRECT NUMBER

GREENWICH
NEWARK
LOS ANGELES
PALM BEACH

(212) 351-3317

September 22, 1998

CONFIDENTIAL

VIA REGISTERED MAIL
(RETURN RECEIPT REQUESTED)

Ms. Laurette Nacamulli
5202 Crossfield Ct., #15
Rockville, Maryland 20852

Re: Reissue Application for U.S. Patent No.
5,527,710 to Nacamulli et al.
Our Ref. No.: KM39091-70

Dear Ms. Nacamulli:

On June 16, 1998 we requested that you execute an Inventor Declaration and Power of Attorney for the above-identified reissue application. A copy of that letter is enclosed. To date, we have not received your response to our request. Therefore, enclosed is a second Declaration and Power of Attorney for your signature.

As discussed in our June 16, 1998 letter, we have been instructed to file a reissue application for U.S. Patent No. 5,527,710 by our client, IGEN, Inc. The reissue application was filed because the issued claims do not provide protection for the entire scope of the invention.

As we have not received your response to our June 16, 1998 letter, enclosed is a second Declaration and Power of Attorney for your execution. The other named inventors, Jonathan K. Leland and Stephanie Hayes, have executed the Declaration. Please review the enclosed materials and forward the executed Declaration to us as soon as possible. We have enclosed a self-addressed envelope for your convenience.

WHITMAN BREED ABBOTT & MORGAN LLP

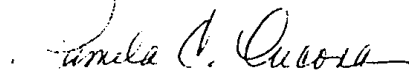
Ms. Laurette Nacamulli

-2-

September 22, 1998

We look forward to receiving the executed Declaration.
If you have any questions, please do not hesitate to contact us.

Very truly yours,



Pamela C. Ancona, Ph.D.
Scientific Consultant

PCA:dmp
Encl.

WHITMAN BREED ABBOTT & MORGAN LLP

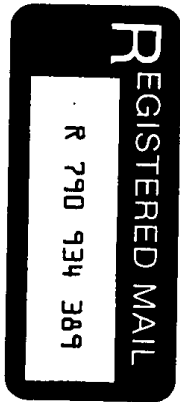
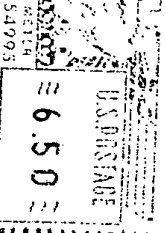
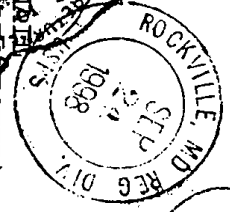
200 PARK AVENUE, NEW YORK, N.Y. 10166

RETURN TO SENDER
(FORWARDING COSTS EXCLUDED)

[Handwritten signature]

[Handwritten signature]

VIA REGISTERED MAIL
(RETURN RECEIPT REQUESTED)
MS. Laurette Macanulli
5202 Crossfield Ct., #15
Rockville, Maryland 20852



BEST AVAILABLE COPY

Registered No. **R 790934389**

Date Stamp



To Be Completed By Post Office	Reg. Fee \$	4.85	Special Delivery \$	
	Handling Charge	\$	Return Receipt	1.10
	Postage \$.55	Restricted Delivery	
	Received by AP			

Domestic postage is limited to \$25,000; International Indemnity is limited (See Reverse)

To Be Completed By Customer (Please Print) All Entries Must Be in Ballpoint or Typed	Customer Must Declare Full Value \$		<input type="checkbox"/> With Postal Insurance
			<input checked="" type="checkbox"/> Without Postal Insurance
	FROM	Pamela C. Ancona, Ph.D. Whitman, Breed Abbott & Morgan LLP 200 Park Avenue New York, NY 10166	
	TO	Ms. Laurette Nacamulli 5202 Crossfield Ct., #15 Rockville, Maryland 20852	

PS Form 3806, February 1995

Receipt for Registered Mail

(Customer Copy)
(See Information on Reverse)

Is your return address completed on the reverse side?	SENDER: ■ Complete items 1 and/or 2 for additional services. ■ Complete items 3, 4a, and 4b. ■ Print your name and address on the reverse of this form so that we can return this card to you. ■ Attach this form to the front of the mailpiece, or on the back if space does not permit. ■ Write "Return Receipt Requested" on the mailpiece below the article number. ■ The Return Receipt will show to whom the article was delivered and the date delivered.		I also wish to receive the following services (for an extra fee): 1. <input type="checkbox"/> Addressee's Address 2. <input type="checkbox"/> Restricted Delivery Consult postmaster for fee.	
	3. Article Addressed to:		4a. Article Number	
	Ms. Laurette Nacamulli 5202 Crossfield Ct., #15 Rockville, Maryland 20852		R 790934389	
	5. Received By: (Print Name)		4b. Service Type	
	6. Signature: (Addressee or Agent) X		<input checked="" type="checkbox"/> Registered <input type="checkbox"/> Certified <input type="checkbox"/> Express Mail <input type="checkbox"/> Insured <input type="checkbox"/> Return Receipt for Merchandise <input type="checkbox"/> COD	
			7. Date of Delivery	
		8. Addressee's Address (Only if requested and fee is paid)		

PS Form 3811, December 1994

102595-97-8-0179

Domestic Return Receipt

BEST AVAILABLE COPY